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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/349,806	07/08/1999	JOSEPH M. JACOBSON	INK-046	7162

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EXAMINER

TALBOT, BRIAN K

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 02/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/349,806

Applicant(s)

JACOBSON ET AL.

Examiner

Brian K Talbot

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 6-20, 24 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6-9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. Applicant's election of Group I, specie a, in Paper No. 13 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Hence, claims 1-5 and 21-23 remain active in the application with claims 6-20, 24 and 25 being directed toward non-elected inventions.

Claim Rejections - 35 USC § 103

2. Claims 1-5 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comiskey et al. (6,177,921 B1) or Jacobson et al. (6,323,989 B1) in combination with Ferguson (5,208,686) or Ferguson (5,345,322).

Comiskey et al. (6,177,921 B1) or Jacobson et al. (6,323,989 B1) teach displays whereby electrodes are printed on a substrate and microencapsulated electrophoretic display capsules can be applied in registration with the electrodes. The capsules can have more than one species of particles corresponding to different colors and can be in registration with either or all of the electrodes. Jacobson et al. (6,323,989 B1) teaches printing to form the electrophoretic display elements and includes ink-jet (col. 8, lines 55-65)

Comiskey et al. (6,177,921 B1) or Jacobson et al. (6,323,989 B1) fail to teach depositing a first plurality of display elements having a first species of particles in registration with a first electrode and depositing a second plurality of display elements having a second species of particles in registration with a second electrode.

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Ferguson (5,208,686) or Ferguson (5,345,322) teach applying capsules with multiple colors as well as applying a first layer of one color followed by a second layer of a different color and if desired a third color. Each capsule with the different color can be responsive to a different voltage or frequency and would be in registration with a pair of electrodes. The first color being in registration with say the bottom electrode while the second color would be in registration with the top electrode. See figures 13-31 of Ferguson (5,208,686).

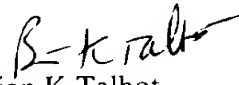
Therefore, it would have been obvious for one skilled in the art at the time the invention was made to have modified Comiskey et al. (6,177,921 B1) or Jacobson et al. (6,323,989 B1) by incorporating multiple capsules with multiple color particles in registration with the electrodes as evidenced by Ferguson (5,208,686) or Ferguson (5,345,322) because of the expectation of similar success.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K Talbot whose telephone number is (703) 305-3775. The examiner can normally be reached on Tuesday-Friday 6AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-6078 for regular communications and (703) 872-9765 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3775.


Brian K Talbot
Primary Examiner
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BKT
February 1, 2002